In this response, no claims are added, canceled, or amended. Thus, claims 1-6 and 8-13 are now pending in the application. Each issue raised in the Office Action mailed November 26, 2008 is addressed below.

I. ISSUES RELATING TO PRIOR ART

A. CLAIMS 1 AND 8 --- 35 U.S.C § 102(e)

Claims 1 and 8 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent 6.349.282 ("Van Aelten"). This rejection is respectfully traversed.

Claim 1 recites the following (emphasis added):

A computer-implemented method of displaying a compound word, the method comprising:

receiving data that specifies a first form of a component word; locating, within said compound word, a second form of said component word that differs from said first form of said component word: and

displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word

wherein the steps of receiving, locating and displaying are performed by a search engine executing in a computer system.

Claim 8 is the computer-readable medium claim corresponding to Claim 1.

Regarding Van Aelten, Van Aelten discloses the detection of compound words in speech recognition systems, in which compound words (received as an "input utterance", see Abstract) are formed from their components. Unlike Applicants' claimed method, Van Aelten starts with input utterances, matches them to words or word fragments, and then pieces them together. Additionally, unlike Applicants' claimed method, Van Aelten uses no search engine to perform any of its method steps.

Consider the example illustrated in Van Aelten and applied in the rejection of Claim

1. According to Van Aelten at column 6 lines 41-43,

Compounding starts with a recognition result input of, for example, "post" "fix" "ing" from the recognition engine.

Then, as shown in Fig. 2, Van Aelten attempts to <u>put the word/word fragments together</u>. The <u>final result of Van Aelten is the compound word</u>. While the method of Van Aelten may have a first component word "fix" and a second component word "fixing", it cannot perform Applicants' claimed step of "locating, within said compound word, a second form of said component word that differs from said first form of said component word" because the method of Van Aelten performs no type of "locating" operation, as the method only attempts to join the word/word fragments together.

As the method of Van Aelten fails to disclose or suggest Applicants' claimed feature of "locating, within said compound word, a second form of said component word that differs from said first form of said component word" and fails to disclose or suggest performing the steps by a search engine, Van Aelten fails to anticipate Applicants' Claims 1 and 9. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

B. CLAIMS 2 AND 9 --- 35 U.S.C § 103(a)

Claims 2 and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Van Aelten, in view of U.S. Patent 5,337,233 ("Hofert"). This rejection is respectfully traversed.

Regarding Claims 2 and 9, Claim 2 is dependent upon Claim 1 and Claim 9 is dependent on Claim 8. The addition of Hofert to Van Aelten fails to remedy the deficiencies of Van Aelten described above, and as the combination of Hofert and Van Aelten fails to

read on Claims 1 or 8, the combination fails to read on Claims 2 and 9. Accordingly,

Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

B. CLAIMS 3-4 AND 10-11 --- 35 U.S.C § 103(a)

Claims 3-4 and 10-11 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Van Aelten, in view of U.S. Patent 6,729,882 ("Noble"). This rejection is respectfully traversed.

Regarding Claims 3 and 10, Claim 2 is dependent upon Claim 1 and Claim 10 is dependent on Claim 8. The addition of Noble to Van Aelten fails to remedy the deficiencies of Van Aelten described above, and as the combination of Noble and Van Aelten fails to read on Claims 1 or 8, the combination fails to read on Claims 3 and 10.

Regarding Claims 4 and 11, Claim 4 recites the following (emphasis added):

A computer-implemented method of determining a position of a component word within a compound word, the method comprising: determining a first stem word associated with said compound word;

determining a second stem word associated with said compound word;

- based on a comparison between letters in said first stem word and said compound word, determining a first starting position;
- based on a comparison between letters in said second stem word and said compound word, determining a second starting position;
- determining, based on said first starting position and said second starting position, a starting position associated with said first stem word;
- determining, based on said first starting position and said second starting position, an ending position associated with said first stem word; and
- displaying said compound word with letters at and between said starting position associated with said first stem word and said ending position associated with said first stem word visibly distinguished from the remainder of said compound word.

Claim 11 is the computer-readable medium claim corresponding to Claim 4.

As explained above regarding the rejection of Claim 1, Van Aelten fails to disclose or suggest either of Applicants' claimed steps of "determining a first stem word <u>associated with said compound word</u>" and "determining a second stem word <u>associated with said compound word</u>" because in Van Aelten each stem word (such as "post" and "fix") is determined <u>prior to</u> determining any compound word (such as "post-fixing"), and thus <u>no association</u> is possible.

The addition of Noble fails to remedy this deficiency of Van Aelten, and as the combination of Noble and Van Aelten fails to disclose or suggest all features appearing in Claims 4 and 11, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

C. CLAIMS 5-6 AND 12-13 --- 35 U.S.C § 103(a)

Claims 5-6 and 12-13 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Van Aelten in view of Noble, and further in view U.S. Pat. Pub. 2005/033565 ("Koehn"). This rejection is respectfully traversed.

Regarding Claims 5-6, Claims 5-6 are dependent upon Claim 4 and Claims 12-13 are dependent on Claim 11. The addition of Koehn to Van Aelten and Noble fails to remedy the deficiencies of Van Aelten described above, and as the combination of Noble and Van Aelten fails to read on Claims 4 or 11, the combination fails to read on Claims 5-6 and 12-13.

Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

II. CONCLUSION

The pending claims not discussed so far are dependent claims that depend on an independent claim that is discussed above. Because each of the dependent claims include the limitations of claims upon which they depend, the dependent claims are patentable for at

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least those reasons the claims upon which the dependent claims depend are patentable.

Removal of the rejections with respect to the dependent claims and allowance of the

dependent claims is respectfully requested. In addition, the dependent claims introduce

additional limitations that independently render them patentable.

For the reasons set forth above, Applicants respectfully submit that all pending claims

are patentable over the art of record, including the art cited but not applied. Accordingly,

allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is

believed that such contact would further the examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is

hereby made. If applicable, a law firm check for the petition for extension of time fee is

enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency

of this application, the Commissioner is hereby authorized to charge any applicable fees and

to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: February 26, 2009

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